REMARKS

With this response, 9 claims are pending. 2 independent claims and 7 dependent claims have been added with this response. Claims 1-30 have been cancelled. Claims 31-39 have been added.

Applicants have included a credit card payment form for $465.00, the small entity fee for a three-month extension of time. Applicants do not believe that any other fees are due at this time; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason relating to this document, the Commissioner is authorized to deduct the fees from Ian F. Burns & Associates, P.C. Deposit Account No. 50-0913.

I. Objection to the Drawings

As the Office requested, the method steps presented in Figures 1-8 have been presented in flow chart form. The Office had objected to the drawings as allegedly not illustrating every feature specified in the claims. The prior claims have been cancelled. In the interest of advancing the case toward prosecution, Applicants make the following remarks regarding new claims 31-39. Claim 31 refers to an interception and emulation unit. The interception and emulation unit may be items such as the SMIB and SMIB-I/O controller shown in, for example, Figure 3. The remote network of claim 32 may be the central computer system of Figure 3. The cash-emulation unit and interception unit of claim 37 may be items such as the SMIB and the SMIB-I/O controller shown in, for example, Figure 3. Applicants assert that Applicants' drawings adequately illustrate the claims and respectfully request that the objection to the drawings be withdrawn.

II. Objection to the Specification

The Office objected to the specification as allegedly disclosing that a keypad was illustrated in the drawings that was, in fact, absent from the drawings. Applicants have amended the specification to clarify that the drawings disclose an input device 34, as illustrated in the drawings, and the input device may include a keyboard. Applicants respectfully request that the objection to the specification be withdrawn.

III. Claim Objections

The Office objected to claims 14 and 28 as having typographical errors in, respectively, the numbering and dependency of the claims. Claims 14 and 28 have been cancelled and Applicants request the withdrawal of the claim objections.

IV. §112, first paragraph rejections

The Office rejected claims 4-6, 8, 10, 13, 15, 17, 19, 20, 22, 24, 25, 27, and 29 under 35 U.S.C. §112, first paragraph, because the claims and specification allegedly failed to convey the meaning of "network communication link to a credit information system" to one of skill in the art. Applicants note that the rejected claims have been cancelled, and respectfully request the withdrawal of the rejection under §112, first paragraph. However, because some of the new claims are directed to this feature of Applicants' invention, Applicants submit the following remarks.

A network communication link to a credit information system is disclosed in several places in the specification. For example Figures 3 and 4 illustrate cash-type gaming machines modified to permit cash-less transactions. Figures 3 and 4 illustrate and describe EFT (electronic funds transfers) between the inventive device and a central computer system. At page 9, the end

of the first full paragraph, the specification suggests that the EFT transactions are conducted with "a player's bank account." In the final paragraph of page 9, carrying over to page 10, the specification teaches that the "SMIB 28 is arranged to communicate with a central computer system 38" which "may provide data to the SMIB 28 such as card verification data, funds data, and the like." Also, at page 16, the specification teaches that, when a player decides to cash-out, the player may choose to have the cash-out performed via EFT to "the player's account, smart card or the like."

Based on a reading of these sections and figures, as well as in light of the teaching of the application as a whole, one of skill in the art would be taught that the inventive device could be connected to a central computer. Furthermore, one of skill in the art would understand that the credit information system includes things such as player accounts and bank accounts, including credit cards, and that the balance of such accounts can be updated according to how much the player has won or lost on the gaming device.

Finally, Applicants note that the claims in the original application form part of the original disclosure and, therefore, are self-supporting. Applicants assert that an appropriate written description of their invention has been provided.

V. §112, second paragraph rejections

The Office rejected claims 1-27 under §112, second paragraph because the Office believes the use of the term "may" renders the claims indefinite. Claims 1-27 have been cancelled, and Applicants request the withdrawal of the §112, second paragraph rejections. However, to the extent any new claims are thought to be subject to similar objection, Applicants submit the following response.

Applicants are unclear how permissive language renders the claims indefinite. Furthermore, Applicants are unaware of any prohibition against permissive claiming.

In the context of their invention, Applicants believe permissive claiming is appropriate. For example, the Office cites claim 1, line 7 as an example of the objectionable language: "whereby the cash emulation processor may emulate at least a portion of the cash transaction unit and thereby receive credit information from, or provide credit information to, the cashless credit system." Permissive language is appropriate in this case because the cash emulation processor does not *always* emulate a portion of the cash transaction unit. The cash emulation unit only performs the emulation function when a user initiates a cash-less transaction requiring the use of the emulator. Applicants believe this language both fairly apprises the public of the metes and bounds of their invention and provides the Office with an adequate basis on which to examine the claims. Courts analyzing such permissive claim language have not found it to be improper. *See Tulip Computers, Int'l v. Dell Computer Corp.*, 236 F. Supp.2d 364, 389-395 (D. Del. 2002). Accordingly, Applicants respectfully request the withdrawal of the rejections of claims 1-27 under §112, second paragraph.

VI. §112, fourth paragraph rejection

Claim 30 has been cancelled. Accordingly, Applicants request the withdrawal of the §112, fourth paragraph rejection of claim 30.

VII. Brief summary of Applicants' Invention

Applicants have provided a novel apparatus and method for retrofitting existing gaming machines to accept new forms of value, such as smart cards, credit cards, vouchers, and the like.

In one embodiment, Applicants achieve this through the use of a Smart Machine Interface Board (SMIB) and a Smart Machine Interface Board Input-Output Controller (SMIB-I/O). The SMIB-I/O may be interfaced directly with the existing game processor of the gaming machine. The SMIB-I/O is adapted to intercept signals from the gaming machine and to emulate signals of the gaming machine. The SMIB-I/O is preferably in communication with the SMIB. The SMIB preferably processes signals received from the SMIB-I/O, is in communication with devices such as card readers and the like, and directs the SMIB-I/O to take appropriate actions in order to carry out cash-less transactions. In this way, Applicants allow existing gaming machines that were not preprogrammed with this functionality to take advantage of technological improvements such as cash-less devices. Applicants' invention is extremely beneficial for gaming proprietors, such as casinos, because they can provide the convenience of cash-less transactions to their customers without incurring substantial costs in replacing or extensively modifying their existing gaming devices.

VIII. §102(b) rejections

The Office rejected claims 7 and 14 as anticipated under 35 U.S.C. §102(b) by U.S. Patent 4,669,596 to Capers et al. (hereinafter, "Capers"). Capers appears to suggest an accessory for use with conventional vending machines. *See* column 1, line 55 – column 2, line 10. The reference suggests that the accessory allows a conventional vending machine to be operated with either money or a coded card. The coded card appears to have the value encoded on the card, rather than the value of the card being ascertained over a network connection to a central database.

Claims 7 and 14 have been cancelled; therefore, Applicants request the withdrawal of the rejections. Furthermore, new claims 31 and 37 explicitly include a gaming device. Capers does not teach a gaming and device and, therefore, does not disclose all elements of Applicants' invention. Accordingly, Applicants' respectfully submit that claims 31-39 are patentable under §102(b) over Capers.

IX. §103 rejections

Rejection over Capers and Crevelt

Claims 1-6, 8, and 15 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Capers in view of U.S. Patent 5,902,983 to Crevelt et al (hereinafter, "Crevelt"). Claims 1-6, 8, and 15 have been cancelled, and Applicants respectfully request the withdrawal of the §103(a) rejections. However, to the extent that the Office intends to apply Capers and Crevelt against the new claims, Applicants submit the following remarks.

The Capers reference has already been discussed. Crevelt appears to suggest a method of using a gaming machine to carry out limited EFT transactions. Crevelt appears to suggest allowing limited EFT transaction in order to provide convenience to the gamer, yet avoid having the gamer over-extend themselves.

The Office asserted that Crevelt discloses "a gaming machine...which has been adapted for cashless transfer." Office Action at 6. The Office further asserted that Figure 2 of Crevelt illustrates a peripheral device attached to the gaming machine that functions as a cash emulation device. *See id.* Unlike Applicants' invention, it appears that Crevelt contemplates building new machines that incorporate its suggestions, rather than retrofitting existing machines. This is illustrated in column 3, lines 19-28 of Crevelt which states that the EFT components are

"integrated into the gaming machine housing." Crevelt does not appear to have any teaching of retro-fitting existing machines to use new technologies.

Similarly, Crevelt does not appear to disclose an emulation device as taught by Applicants. Applicants' emulation device provides an interface for new devices to interface with existing electronics and hardware. Applicants submit that this is quite different from building a new machine with electronics that are a priori designed to carry out all of the functions of the machine. Independent claims 31 and 37 specifically include language directed to the retrofit character of their invention.

Applicants submit that one of skill in the art would not be motivated to combine Crevelt and Capers. The method of operation of Crevelt is very different from that of Capers. Furthermore, one of skill in the art would find no motivation to combine the retro-fitted vending machine of Capers with the method of providing limited EFT functionality suggested by Crevelt.

Rejection over Capers, Crevelt, and Perrie

Claims 9-13 and 16-30 were rejected under §103(a) over Capers in view of Crevelt and further in view of U.S. Patent 6,173,955 to Perrie et al. Claims 9-13 and 16-30 have been cancelled, and Applicants respectfully request the withdrawal of the rejections. However, to the extent the Office believes Capers, Crevelt, and Perrie to be relevant to the patentability of claims 31-39, Applicants submit the following remarks.

Perrie appears to suggest a method and apparatus for providing a casino version of the home game of YAHTZEE. *See, e.g.*, column 1, line 55 – column 2, line 22. The Office cited column 7, lines 48-53 and column 8, lines 10-20 of Perrie for the proposition that Perrie discloses various methods of cashing-in and cashing-out. Perrie does appear to cursorily mention ways of cashing-in and cashing-out, however it does not appear that this is what Perrie

is directed to, nor does it appear that Perrie contains any detailed teaching regarding the methods it mentions.

The Office went on to state that, because Perrie purportedly suggests crediting a smart card, Perrie "provide[s] an interception to the cash out process by altering the cash out process by altering the normal procedure for cashing out," and that, therefore, "Axiomatic to the functionality of Perrie et al. there is a type of interception processor that will control this action." *Id.*

As with Crevelt, the function of Perrie cited by the Office is simply not the same as the function disclosed and claimed by Applicants. Patent law is clear that "Claims must be read in view of the specification, of which they are a part." *Markman v. Westview Inst., Inc.*, 52 F.3d 967, 979 (Fed. Cir. 1995). Similarly, the Federal Circuit has stated that "A patent claim is construed by examining the claim in the context of the specification, drawing on the specification for an understanding of what is covered by the claim...." *Pall Corp. v. Hemasure, Inc.*, 181 F.3d 1305, 1309 (Fed. Cir. 1999).

A review of Applicants' specification discloses that Applicants' are primarily concerned with retro-fitting gaming machines to use new technologies, such as credit cards, smart cards, and the like. These machines were not manufactured to take advantage of these new technologies. Applicants have provided a device capable of interfacing with the gaming machines and allowing new technologies to be used by the existing gamine machines. When interpreting Applicants' claims, their disclosure and purpose must be kept in mind.

Applicants teach two things of particular relevance to the present discussion. First, Applicants teach "intercepting" signals of the gaming machine. For example, a first device, such as the Smart Machine Interface Board Input-Output Controller (SMIB-I/O), may intercept a signal within the device that indicates that the coin hopper has been activated. *See* page 12, final

paragraph. The intercepted signal can then be transmitted to a second device, such as the Smart Machine Interface Board (SMIB) taught by Applicants, which then processes the intercepted signal and determine appropriate actions to be taken.

Second, Applicants teach "emulating" signals of the gaming machine. For example, when directed by the SMIB, Applicants teach that a simulated coin-dispensing signal can be sent from Applicants' the SMIB-I/O device to the gaming machine processor. The interception and emulation functionality allows Applicants invention to be used to allow preexisting gaming machines to take advantage of new technological developments without extensive or expensive modifications.

Perrie, as was the case with Crevelt, does not disclose "interception" or "emulation" as taught by Applicants. Although these references may suggest a machine to engage in both cash and credit transactions, these references do not appear to teach or suggest using a second device to intercept or emulate the signals or functions of a first device. Rather, it appears that devices contemplated by Crevelt and Perrie were preprogrammed with the functionality to engage in both cash and cash-less transactions. Therefore, no "intercepting" or "emulation" appears to be used or required for machines constructed according to Crevelt or Perrie. In fact, Applicants specifically distinguish these types of machines in their specification, noting that their invention is intended for machines that were not so preprogrammed. *See* page 3, first full paragraph.

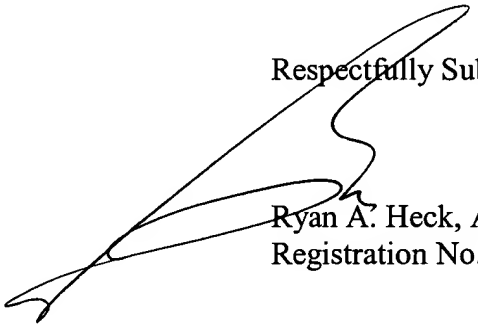
Because Perrie and Crevelt do not teach the emulation or intercepting functions of Applicants' invention, Applicants traverse the Office's arguments that Perrie and Crevelt may be used to render Applicants' invention obvious. As has been discussed, and as is explicitly stated in Applicants' specification, devices of the type of Perrie and Crevelt are precisely what Applicants are trying to avoid through their invention. Accordingly, Applicants respectfully assert that neither Capers, Crevelt, Perrie, nor their combination renders Applicants' claims

obvious. Applicants respectfully request the withdrawal of the §103(a) rejections and believe the present claims are in condition for allowance.

CONCLUSION

For all of the above reasons, the Applicants submit that the present application is in condition for allowance. If the Examiner has any questions regarding the application or this Amendment, the Examiner is encouraged to call the Applicants' attorney, Ryan A. Heck, at (775) 826-6160.

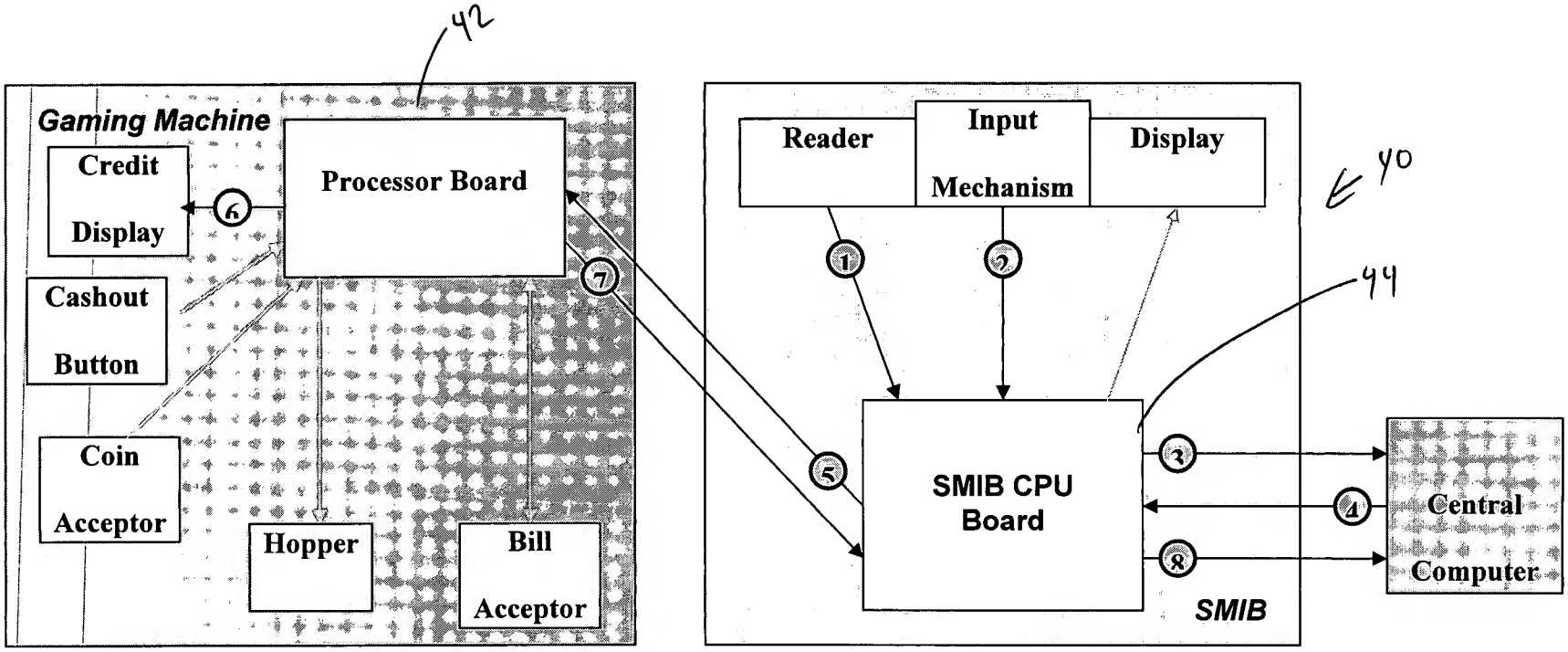
Respectfully Submitted



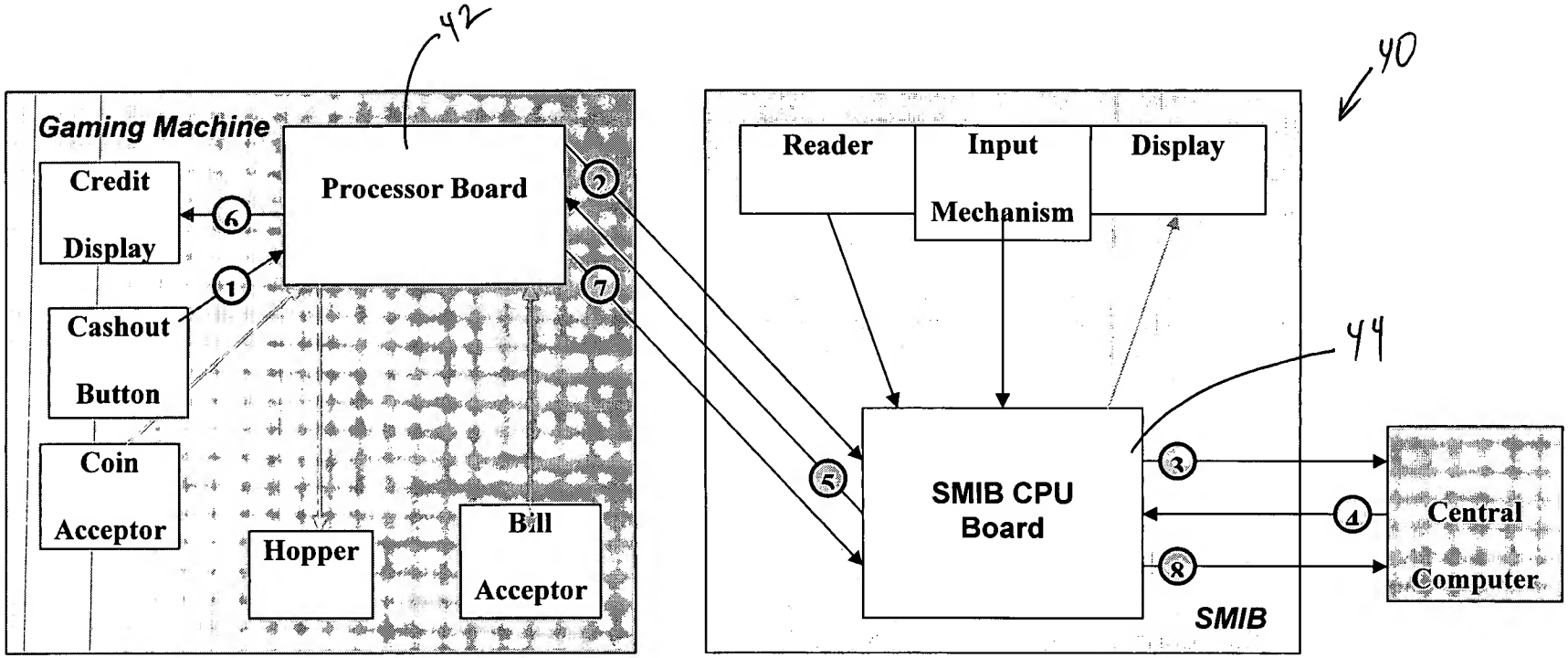
Ryan A. Heck, Attorney for Applicants
Registration No. 51,795

May 30, 2003

Prior Art Method for EFT Transfers from System to Gaming Machine
Figure 1

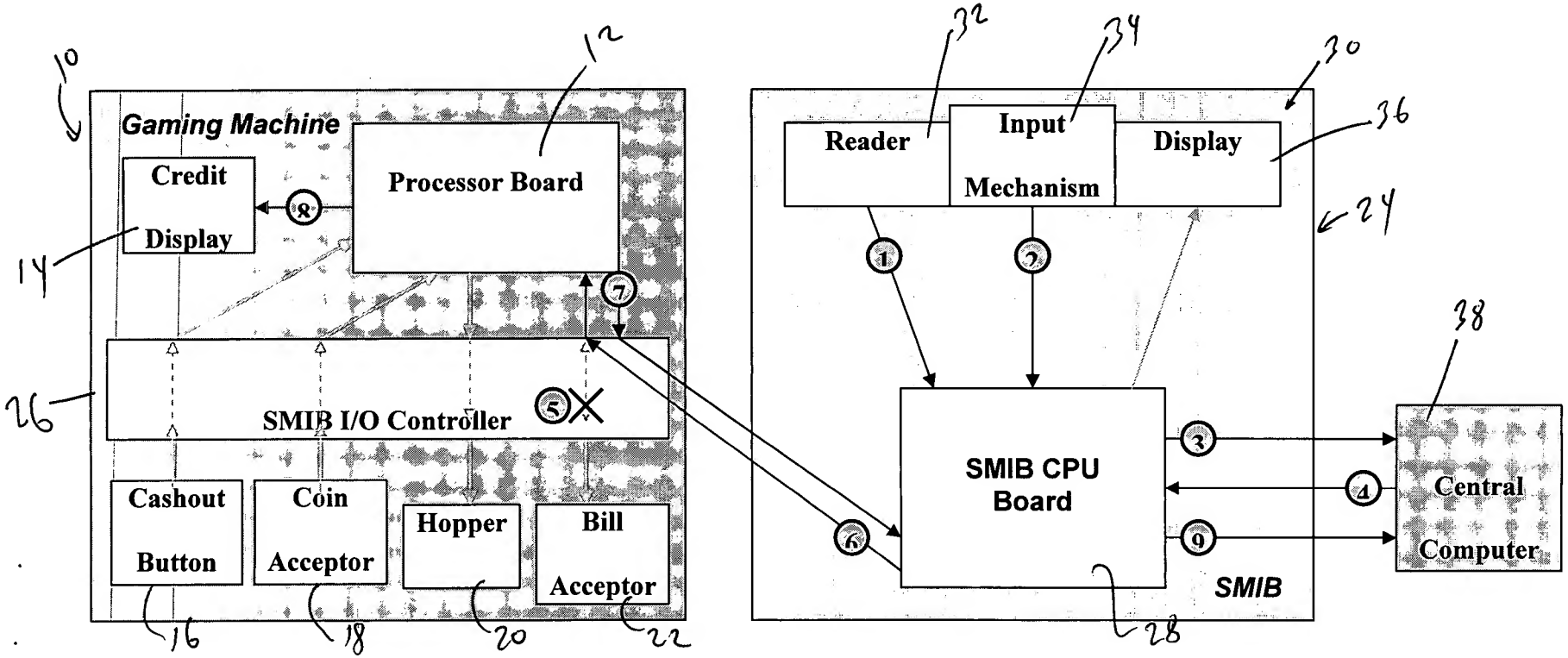


Prior Art Method for EFT Transfers from Gaming Machine to System
Figure 2

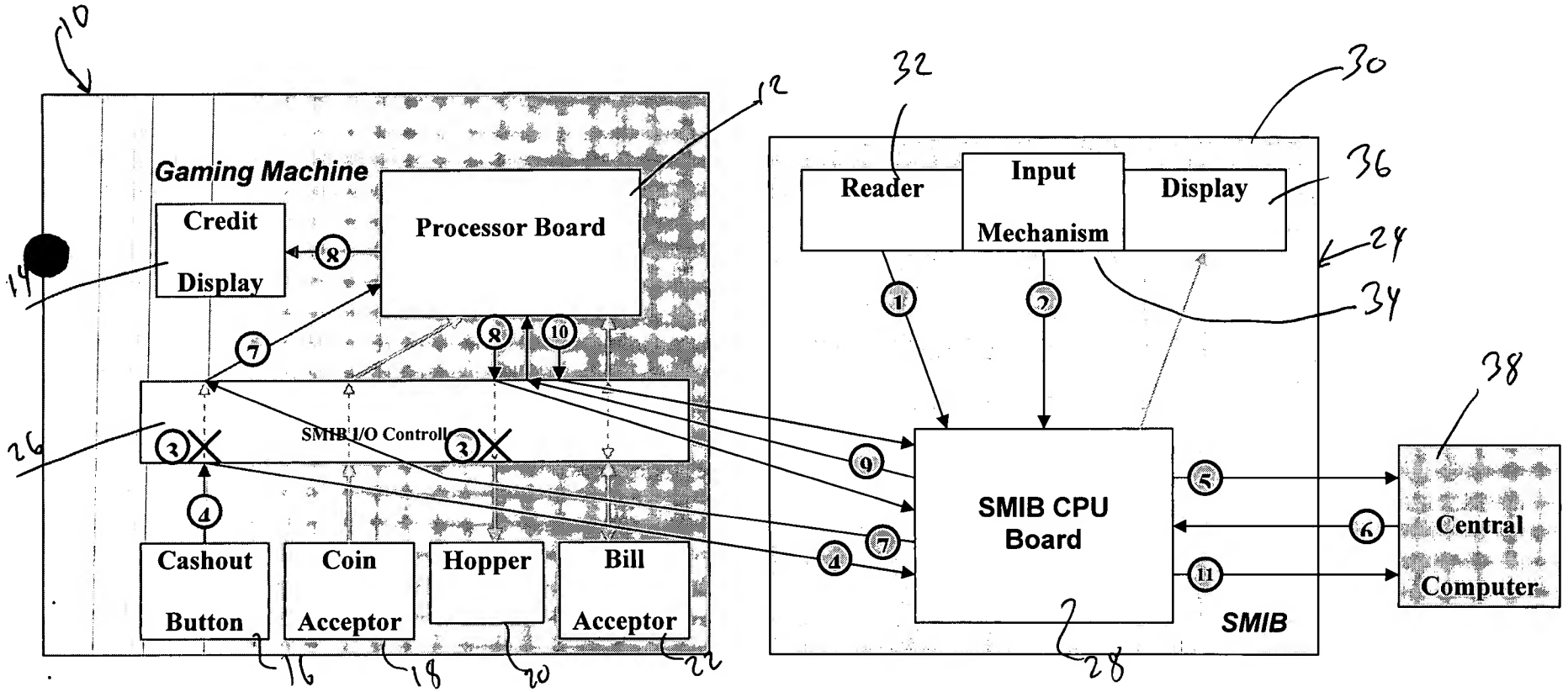


Method for EFT Transfers from System to Gaming Machine
Figure 3

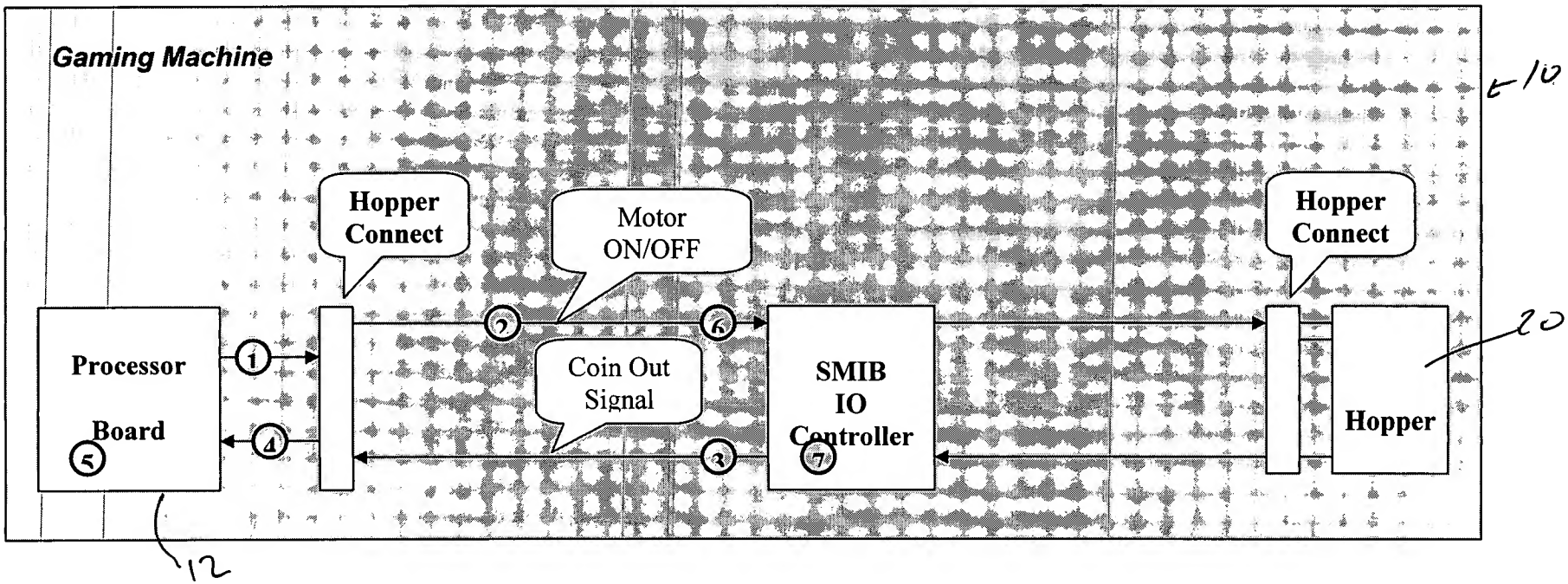
11/16



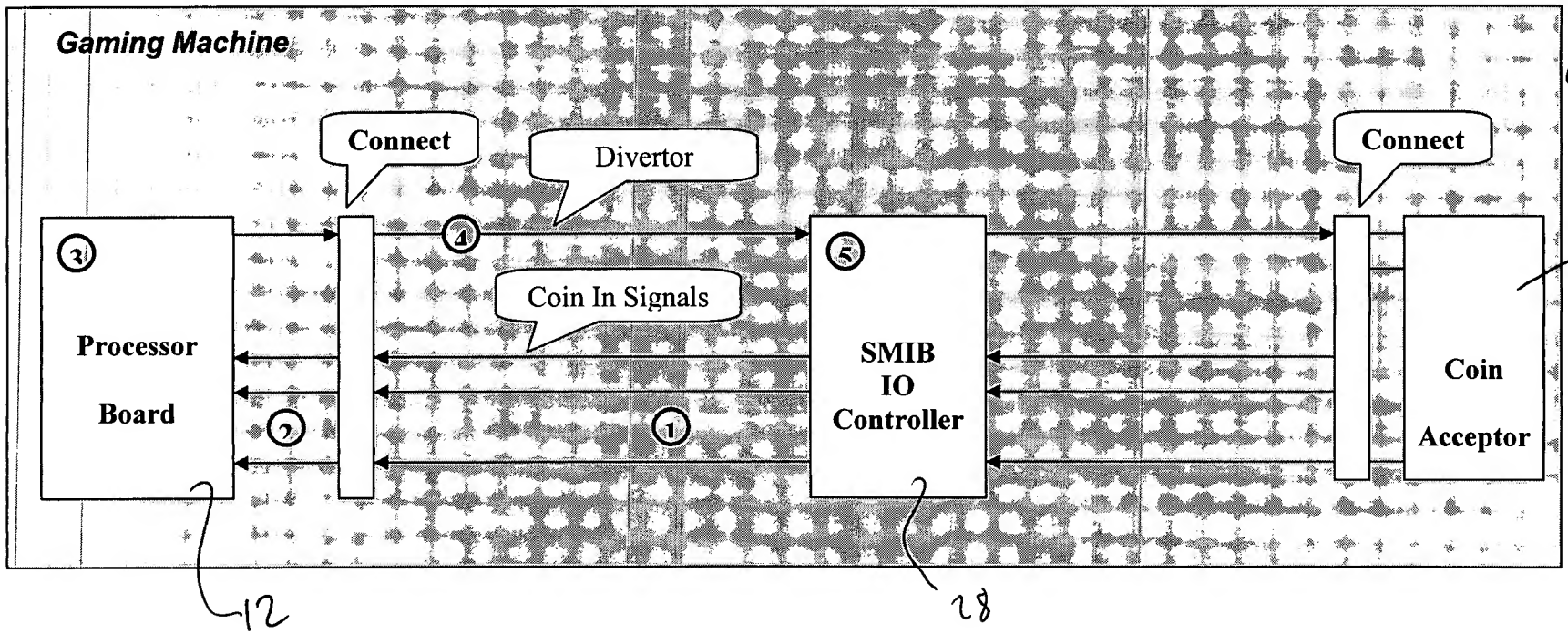
Method for EFT Transfers from Gaming Machine to System
Figure 4



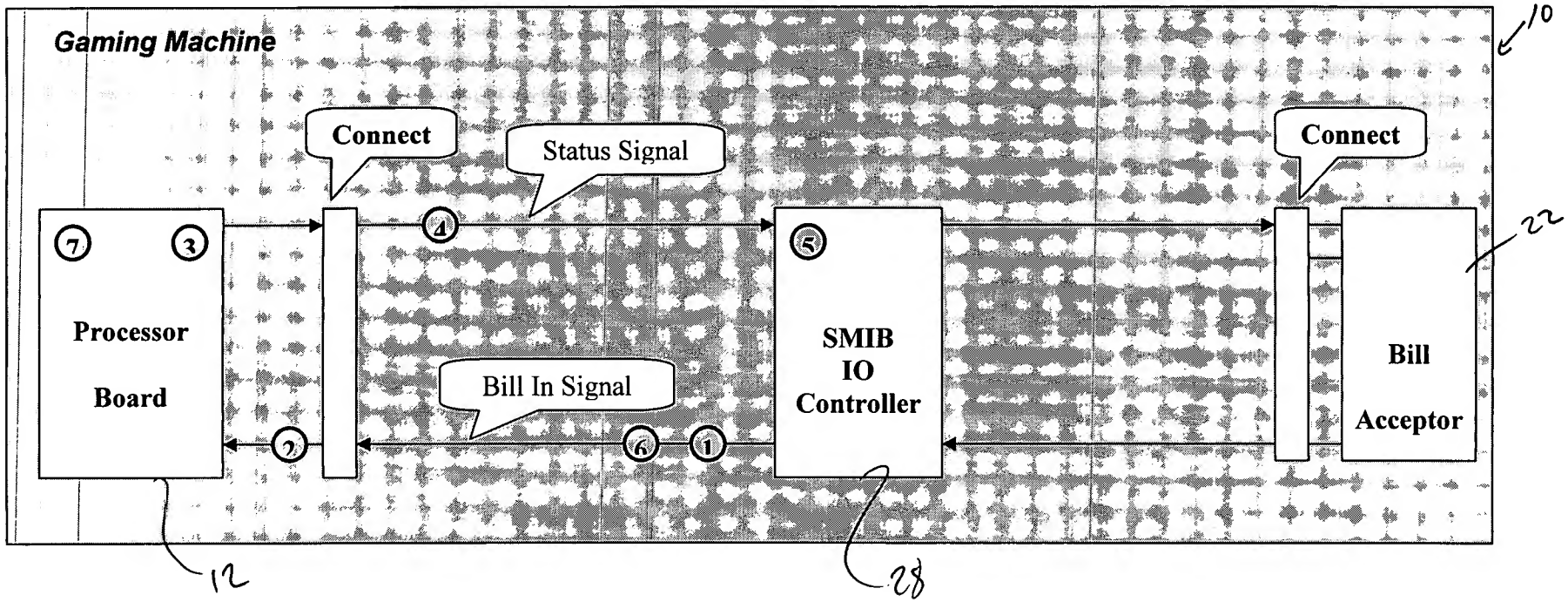
Method for simulating a hopper pay from a Gaming Machine.
Figure 5



Method for simulating a coin in transaction using the coin acceptor signals to a Gaming Machine.
Figure 6



An AGI Method for simulating a bill transaction using the bill acceptor signals to a Gaming Machine.
Figure 7



Method for intercepting the cash out button on a Gaming Machine.
Figure 8